

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 17, 2006. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 4, 6, 8 and 20 have been amended to further define the present invention. Applicants respectfully request reconsideration of the claims, as amended, and the remarks below and favorable action in this case.

### **Rejections under 35 U.S.C. § 102**

Claims 1-20 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,697,882 or U.S. Patent No. 5,871,469 or U.S. Patent No. 5,683,366 all issued to Eggers et al. (“Eggers”). Claims 1, 3-11, 17-20 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,936,281 issued to Stasz (“Stasz”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

As amended, Claim 1 specifically recites that the “active electrode comprises *an end having an open electrode port in communication with the electrode lumen and a body having a suction opening formed therein.*” Emphasis added. The method of Claim 20 also specifically recites that the electrode includes an end port and an opening formed in the wall of the electrode.

The Eggers references disclose an electrosurgical tool that includes a port formed at the terminal end (see Fig. 20) but does not disclose a suction opening formed in the body of the electrode. Similarly, Stasz teaches an electrosurgical apparatus with an opening at the tip (see Fig. 2) but does not disclose, teach or suggest an additional opening formed in the body of the apparatus.

Because the cited references do not teach each and every recited element, they cannot anticipate the present Claims 1 and 20 or the Claims that depend therefrom. Accordingly,

Applicants respectfully request reconsideration, withdrawal of the rejections under §102 and full allowance of Claims 1, 20 and Claims 2-19 that depend therefrom.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with a copy of the reference, for the Examiner's review and consideration.

**CONCLUSION**

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180.00 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicants also request a one month extension of time. The Commissioner is hereby authorized to charge the requisite extension fee and any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effect this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.391.3961.

Respectfully submitted  
Attorney for Applicants,



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Date: 12/18/2006

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Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with a copy of the reference